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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,493	03/23/2000	Oscar Jimenez	20037	1061

7590 12/19/2001

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Barrington, IL 60010

EXAMINER
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THISSELL, JEREMY

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 12/19/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/533,493

Applicant(s)

JIMENEZ, OSCAR

Examiner

Jeremy T. Thissell

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Tovey (US 5,445,140).

Tovey teaches all the claimed subject matter including a catheter with a shape memory tip as claimed (abstract; and col. 3, lines 28 and 44).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tovey in view of Bley et al (US 5,762,630).

Tovey teaches all the claimed subject matter except for the claimed shore D hardnesses. Bley teaches a shape memory catheter wherein the disclosed material comprises polyurethane (col. 4, lines 44-45) is radiopaque (col. 5, line 40), and is taught to have a durometer of 78 D when its temperature is below the glass transition temperature ( $T_g$ ) and a durometer of 25 D when its temperature is above  $T_g$ . Bley teaches that  $T_g$  is between 15-35° C, and further states that materials with varying glass transition temperatures may be used (col. 5, lines 17-22).

In addition, Bley teaches that a suitable material is MM-3510 made by Mitsubishi Heavy Industries (col. 4, line 45), which is substantially similar to MM-3500 which is also a polyurethane-based material made by Mitsubishi and is disclosed as the material of choice by applicant on page 3 of their own specification.

It would have been obvious to one of ordinary skill in the art to choose a material with the claimed properties (which are only slightly different than those discussed by Bley), particularly in view of Bley's statement in col. 5, lines 17-22. Further, it would have been obvious to one of ordinary skill in the art to use such a material for the device

of Tovey in order to insert the device into the tortuous passageways of the human anatomy.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tovey in view of Frantzen et al (US 5,776,114).

Tovey teaches all the claimed subject matter except for the tubular member having a shape memory outer "jacket". Frantzen teaches the well-known structure of a shape memory outer sheath for a catheter (col. 5, lines 66-67). It would have been obvious to one of ordinary skill in the art to form the shape memory portion of Tovey with a shape memory outer "jacket" as taught by Frantzen in order to provide the inner surface of the device with a lubricious surface (i.e. different material) as is well known in the art of catheters and endoscopes.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tovey in view of Park et al (US 6,159,187).

Tovey teaches all the claimed subject matter except for the braided tubular structure between two extruded tubes. Park teaches the well known braided structure as claimed. It would have been obvious to one of ordinary skill in the art to form the device of Tovey with a sandwiched braid as taught by Park in order to improve strength while maintaining flexibility as is known in the art.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tovey in view of Griep (US 5,163,431).

Tovey teaches all the claimed subject matter except for the tip being "tapered" and welded or molded on to the main tubular member. Griep teaches a well-known "tapered" tip, which is an obvious variant of the hemispherical or "rounded" tip of Tovey. Griep also teaches that the sections of catheter can be welded together (col. 4, line 20) as is also well-known in the art. In view of Tovey's teaching that other methods for securing the sections will be apparent to those skilled in the art (col. 3, lines 14-19), it would have been obvious to join the sections of Tovey by conventional and well-known welding techniques disclosed by Griep.

**Contacts**

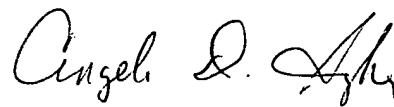
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy T. Thissell whose telephone number is (703) 305-5261. The examiner can normally be reached on 8:30-7:00 Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached at (703) 308-5181. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-3590 for regular communications and (703) 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

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December 16, 2001



**ANGELA D. SYKES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700**

Attachment for PTO-948 (Rev. 03/01, or earlier)  
6/18/01

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.